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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,259	07/24/2003	Zhong Ding	961_013NP	9582

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EXAMINER

GORDON, BRIAN R

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/626,259

Applicant(s)

DING ET AL.

Examiner

Brian R. Gordon

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 7-24-06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date = _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed July 24, 2006 have been fully considered but they are not persuasive. Applicant asserts Hughes does not disclose a tip including upper and lower openings as claimed. Applicant attempts to validate such assertion by comparing the claimed invention to the bottle 14. The examiner has not cited the bottle as being equivalent to applicant's metering tip. The squeeze bottle is an element disclosed as being used in combination with the plastic cap 31, which the examiner considers to be equivalent to applicants tip. It is clearly disclosed and shown in the figures that the squeeze bottle is attached to an opening of the cap tip that is located at an opposite end to a second orifice/opening (32, 42). As to the comments directed to the lower tip opening being used for aspirating and dispensing fluid, this is directed to how one intends for the metering tip to be used. The intentional use of the device is not a valid argument for distinguishing between the structure of the claimed invention and that of the prior art. If one chooses one can simply employ, applicant's invention for aspirating only and the structure would remain the same. However regardless of such, the cap (tip) as disclosed by Hughes is structurally capable of being employed for dispensing and aspirating. If one so chooses, when the squeeze bottle is attached to the cap, one can squeeze the tip to dispense liquid or place the cap in a fluid and allow the squeezed bottle to return to its original shape thereby creating a vacuum for aspirating a fluid therein.

Applicant further asserts, "A careful reading of Hughes and examination of Fig. 4 indicates clearly that the bottle is a single molded article - the dispensing/cap end being integral therewith, that is, continuous and inseparable from the bottle." Applicant fails to provide where Hughes discloses such a statement. Instead applicant attempts to rely on Figure 4, to evidence such an assertion. However, one can clearly see the bottle and cap are distinctly two different elements, which one can distinguish as such if one views the shading lines of the walls/boundaries of both respective elements. The lines clearly slant in two different directions. If the elements were a single molded article, the lines would be slanted in the same identical direction. Furthermore, such analysis of the drawings is not required when a complete contradiction of applicant's assertion is evidenced in claim 1 (column 5, line 4 of the reference; see also claim 9) clearly states "a removable cap".

As to the 103 rejections in view of Treptow et al., the suggestion to employ optical windows is clearly provided in Treptow et al. (as disclosed herein). Applicant asserts Treptow does not disclose internal stepped areas. It is not required that Treptow disclose stepped areas. As stated Hughes discloses the stepped areas. Treptow is a secondary reference provided to show the obviousness of employing optical windows for performing analysis as disclosed. It should be noted that one's motivation for combining references is not required to be that as the same of that of applicant.

For reasons given herein, the 102 rejections of claims 1-2 and 103 rejections of claims 3-8 and 10 are hereby maintained.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 9-12 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 9-10 have been amended and new claims 11-12 added. Applicant has not specified where the amendments and new claims are supported in the original specification. After a brief review of the specification the examiner fails to locate the method as claimed. Where is the moving step (ii) of claim 9 supported? Where is it stated fluid is aspirated past the sharp diametrical edge of a stepped area? Where is the drawing and seal step disclosed as being performed prior to spectrophotometric reading? Applicant should point out where the method as claimed is specifically disclosed in the specification.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 10 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

While the tip is disclosed as having a window included in its structure, it is unclear when the disposing step as recited in claim 10 occurs. It would seem that the window is created in the tip during the manufacturing of the tip. It appears the phrase should not read said method including the further step of, but yet read wherein said at least one stepped are is located above the read window.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Hughes US 3,449,081.

Hughes discloses a tapered, plastic cap (tip) that includes upper and lower openings and stepped portions therein (see Figures 4 and 6):

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 3-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hugs as applied to claims 1-2 above, and further in view of Treptow et al. US 5,844,686.

Hughes does not disclose the plastic cap as including a "window" as claimed.

Treptow et al. disclose an apparatus for pipetting and photometrically evaluating samples which comprise a pipetting means, an integrated photometer and a replaceable pipette tip connected to said pipetting means, said pipette tip being defined as a cell and provided within the optical path of the photometer for photometrically evaluating absorbed samples (abstract).

The pipette tip 4 within the area of the optical path 6, 7 comprises two plane-parallel windows 8, 9 on opposite sides of its wall.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the cap/tip of Hughes et al to incorporate the optical windows as

taught by Treptow in order to provide a cap of test kit to allow for "on-the-spot"-analytics of the samples.

As to the method claims, it would have been obvious to recognize that upon aspirating fluid in the modified structure of Hughes, the same steps of the claim method would occur.

### ***Conclusion***

11. No claims allowed.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, with 2nd and 4th F off.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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